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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Timothy A. Bekkedahl et al

Serial No. 10/722,946

Filed: November 26, 2003

Title: FUEL CELL HAVING A HYDROPHILIC  
SUBSTRATE LAYER

Examiner: Shermanda L. Williams

Art Unit: 1745

Docket No. C-2370B

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being facsimile  
transmitted to the United States Patent and Trademark  
Office (Fax No. 571-273-8300) on March 24, 2006.

Barbara Cecere



RESPONSE

This is responsive to the Office Action dated February 6, 2006. Claims 1-3  
are allowed; claims 1-5 remain for consideration.

**Response to Preliminary Remarks**

MPEP 707.07(f) states: "Where the applicant traverses any rejection, the  
examiner should, if he or she repeats the rejection, take note of the applicant's  
argument and answer the substance of it." Form paragraph 7.37 requires: "2. In  
bracket 2, provide explanation as to non-persuasiveness." Applicants' arguments  
have not been addressed.

**Oath/Declaration**

The declaration in this application Serial No. 10/722,946 is a copy of the  
declaration in continuation parent Serial No. 10/012,157 as set forth in sections 5b.  
and 18 of PTO/SB/05 filed as part of this application. Serial No. 09/466,701 was  
pending when Serial No. 10/012,157 was filed. Withdrawal of the requirement for  
a substitute declaration is requested.

Reference to PTOL-85 is not understood.

## Rejections -102

Claims 4 and 5 are rejected as anticipated under -102(e) by Dufner. The rejection admits (near middle of page 4) that Dufner does not disclose pressure differential of "more than 0.2 psi and less than 1.7 psi", as called for in claims 4 and 5. In re Wertheim is inapposite, relating only to overlapping ranges, which is discussed in MPEP 2131.03 II.

The rejection of claim 4 in the parent application was based on "about 2...encompasses 1.5 to less than 2....1.5 to 1.7 is about 2 to one significant figure." That argument was made by the USPTO solicitor in footnote 4 of Titanium Metals v. Banmer, 777 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). (See MPEP 2131.03 III.) The CAFC disregarded that argument (227 USPQ 777), inter alia, "as contrary to many holdings in this court and its predecessors that anticipation under §102 can be found only when the reference discloses exactly what is claimed and that where there are differences...the rejection must be based on §103 which takes differences into account."

The correct law is in MPEP 2131.03 III, which cites Titanium, supra.

It is respectfully submitted that the rejection is plainly contrary to law and should be withdrawn. Reconsideration and allowance of claims 4 and 5 is respectfully requested.

## Rejections -103

Claims 4 and 5 are rejected as obvious over Dufner et al in view of Reiser.

At the time the claimed invention was made (1) both the patent to Dufner et al and the patent to Reiser were owned by International Fuel Cells, LLC, and (2) the inventors of this application were all under an obligation of assignment to International Fuel Cells, LLC, the assignee of this application and its parent and grandparent, Serial No. 012,157 and Serial No. 09/466,701, respectively. International Fuel Cells, LLC has since changed its name to UTC Fuel Cells, LLC; a copy of the name change is herewith.

Both references are disqualified. Therefore, the rejection should be withdrawn. (It is noted that In re Boesch is inapposite, since it involves overlapping ranges.)

For the foregoing reasons, reconsideration and allowance of claims 4 and 5 is requested.

Should the foregoing not be persuasive in any respect, a telephone interview is most earnestly requested.

Respectfully submitted,



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